

Application No.: 10/055,968
Docket: 103864.129 US1

REMARKS

Applicants thank the Examiner for withdrawing the rejections to claims 43-53 under 35 U.S.C. § 101. The application has been amended to more clearly define the present invention. In particular, claim 18 is amended to provide proper antecedent basis and claim 69 is amended to correct a typographical error. New claims 70-74 are added to further define what Applicants considerer to be his invention. No new matter is added.

In addition, independent claims 1, 37, 38 and 74 have been amended responsive to the previous Advisory Action.

Reconsideration is respectfully requested.

I. Claim Objections

Claims 1, 19, 37, 38 and 74 are objected due to grammatical informalities. Applicant appreciates the thorough review by the Examiner, and has corrected the claims in a non-narrowing manner.

Applicant respectfully submits that the objections to the claims have been corrected, and requests that the objection be withdrawn.

II. Claim Rejections – 35 U.S.C. §§ 102 and 103

Claims 41 and 61 are rejected under 35 U.S.C. §102 as being anticipated by Reese (U.S. Patent 6,711,460) and claims 1-8, 13-27, 29-37, 39, 42-45, 47-57, and 62-63 are rejected under 35 U.S.C. §103 as being unpatentable over Reese in view of Haitin et al. (U.S. Patent 6,636,780) and Walker et al. (U.S. Patent 5,883,370). Applicant respectfully traverses this rejection.

First, Applicant submits that Reese (U.S. Patent 6,711,460) is NOT prior art because the filing date for Reese is June 14, 2002, which is AFTER the present application's filing date of

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January 28, 2002. Accordingly, the recitation in the rejections to the specific columns/lines of Reese is respectfully submitted as inappropriate. Therefore, the present rejections should be **WITHDRAWN** for these reasons alone.

In addition, while Reese claims priority to a provisional patent application that pre-dates the present application's filing date, the only subject matter that may be used in a prior art rejection is that subject matter that is common to both the provisional application and the Reese patent.

The Examiner graciously provided detailed reasons regarding reasons for allowance. In particular, the Examiner has indicated that the prior art does not convert a prescription request and does not store a digitized prescription request. In addition, the prior art does not compare at the prescription processing system a physician's phone number and a prescription number. Further, the prior art does not teach a header entry agent for obtaining general information from a digitized prescription request at the prescription processing system. The Examiner has further stated that the prior art does not convert the captured prescription request to a digitized format, create an identification file and associate the identification file and the prescription request to form a prescription file.

The Examiner also admits that Reese does not disclose the use of a unique identifier recited, for example, in claims 13, 14, 26 and 27. In addition, Applicant disagrees with the Examiner that Reese shows the "determining if there is a change in patient therapy that would affect one or more aspects of the prescription request, and if there is no change in patient therapy then performing the steps of reviewing the submitted prescription request to obtain a user's approval". Further, Reese does not appear to show that "when there is a change in therapy, further comprising the steps of requesting new medication information from the user and reviewing the new medication information".

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To expedite prosecution, Applicant has further amended one or more of the claims in accordance with the allowable subject matter as indicated by the Examiner.

In addition, Applicant provides the following remarks.

1. Claims 1-8, 13-27, 29-36

Claim 1 states in combination:

A method of processing prescription requests comprising the steps of:

- establishing a connection to a remotely located prescription processing system;
- submitting a prescription request to the prescription processing system;
- capturing the prescription request for subsequent manipulation;
- converting the captured prescription request to a digitized format at the prescription processing system to obtain a digitized prescription request;
- storing the digitized prescription request on a database maintained by the prescription processing system;
- independently assessing by personnel associated with the prescription processing system correctness of the prescription request;
- preparing by said personnel a completed prescription form based on the submitted prescription request;
- sending the completed prescription form to a filling pharmacy; and
- filling the prescription request, at the filling pharmacy, based on the completed prescription form.

Without conceding that Reese, Haitin et al. and/or Walker et al. shows any of the elements of claim 1, the prior art does not disclose, for example, “independently assessing by personnel associated with the prescription processing system correctness of the prescription request,” combined with the remaining limitations recited in claim 1. As Figure 1 in the present Application illustrates, the “personnel” that independently assesses the correctness of the

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prescription request, for example, the "in-house pharmacist" of Figure 1, is a separate entity from the physician who creates the prescription request.

Even combining the teachings of the prior art, the combination of elements of claim 1, when interpreted as a whole, is not disclosed. As the combination of elements of claim 1 are not disclosed when claim 1 is interpreted as a whole, Applicants respectfully request that the Examiner withdraw the rejection with respect to claim 1 and its dependent claims 2-8, 13-27, 29-36 and 54-55 which incorporate all of the features of claim 1. Moreover, dependent claims 2-8, 13-27, 29-36 and 54-55 are independently patentable based on the combination of elements recited therein.

2. Remaining Claims 37, 39, 41-45, 47-53, 56, 57, 59, 61-63 and 70-73

Applicant has amended the relevant independent claims 37, 39, 41-45, 47-53, 56, 57, 59, 61-63 and 70-73 to incorporate one or more of the Examiner's indication of allowable subject matter. Accordingly, Applicant respectfully submits that the combination of limitations in each of the independent and dependent claims 37, 39, 41-45, 47-53, 56, 57, 59, 61-63 and 70-73 patentably distinguishes over the prior art. Withdrawal of this rejection is respectfully requested.

In addition, each of the combination of limitations recited in claims 37, 39, 41-45, 47-53, 56, 57, 59, 61-63 and 70-73, includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, Applicant respectfully requests withdrawal of the rejection.

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art, the combination of elements of claims 37, 39, 41-45, 47-53, 56, 57, 59, 61-63 and 70-73, when each is interpreted as a whole, is not disclosed. As the combination of elements of the claims is not disclosed, Applicant respectfully requests that the Examiner withdraw the rejections.

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III. Response to Arguments

In view of the above arguments, Applicant respectfully contends that the art of record, taken alone or in combination, does not disclose all of the features of the present invention as claimed in claims 1-74. As such, Applicant respectfully requests allowance of claims 1-74.

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CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

In addition, each of the combination of limitations recited in the claims includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, Applicants respectfully request withdrawal of the rejection.

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art are combined, the combination of elements of claims, when each is interpreted as a whole, is not disclosed in the Examiner's proposed combination. As the combination of elements in each of the claims is not disclosed, Applicants respectfully request that the Examiner withdraw the rejections.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present

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claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

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AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to deposit account no. 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to deposit account no. 08-0219.

Respectfully Submitted,

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